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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,728	01/19/2000	Toshihiro Shima	Q57645	3501

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EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2622

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/487,728

Applicant(s)

SHIMA, TOSHIHIRO

Examiner

CHAN S PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/4/05 has been entered.

Response to Amendment

2. Applicant's amendment was received on 2/4/05, and has been entered and made of record. Currently, **claims 1-18** are pending.

Response to Arguments

3. Applicant's arguments with respect to **claims 1-18** have been considered but are moot in view of the new ground(s) of rejection.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Claim 12 recites that a file transfer protocol file server is included in a printer. However, referring to fig. 1 of the corrected drawing filed on 5/16/00, it is uncertain as to which device performs as the file transfer

protocol server. Therefore, the printer having the file transfer protocol server must be shown or the features canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

The following quotations of 37 § CFR 1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

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5. Claim 10 recites the limitation "the first printer". There is insufficient antecedent basis for this limitation in the claim. Perhaps, "the first printer to receive said print data transmits to said different printer said print data stored in said storage means" should be replaced with -- said print data stored in said storage means is transmitted to said different printer --.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 and 11-18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mori et al. U.S. Patent No. 6,292,267 (hereinafter Mori).

6. With respect to claim 1, Mori discloses a printer (network printer apparatus 20), which is connected to a computer network via a network (fig. 2), comprising:

transfer means for exchanging information with said computer via said network (col. 7, lines 5-17);

storage means (hard disk 24) for storing a document file to be printed that is received from said computer via said transfer means (col. 6, lines 42-44 & col. 7, lines 26-29);

configuration file generation means for employing print setup information in said document file, which is received from said computer via said transfer means, to generate a configuration file concerning a print setup for said document file (col. 7, lines 30-40);

print setup reference means for employing said configuration file to generate a menu indicating contents of said print setup, and for transmitting said menu via said transfer means to said computer (fig. 23 & col. 20, line 54 – col. 22, line 60);

printing means for printing said document file that is stored in said storage means in accordance with said configuration file (col. 20, line 54 – col. 22, line 60); and

setup change means for, when said computer operates said menu via said transfer means, updating contents of said print setup in accordance with the operation (col. 19, lines 1-18).

Also, read col. 7, line 18 – col. 8, line 46.

7. With respect to claim 2, Mori discloses the printer according to claim 1, wherein when said computer operates said menu via said transfer means, said setup change means updates contents of said configuration file in accordance with the operation (col. 19, lines 1-18).

8. With respect to claim 3, Mori discloses the printer according to claim 1, wherein said menu (figs. 23 & 24) includes upper directories that are generated for individual entries in said print setup (either one of 41 or 44), and lower directories that are generated for individual setup values (hold and priority values in 45), one of which is included in each of said entries, and wherein said menu is formed by correlating visual

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display elements corresponding to said document file with said lower directories (file names displayed in fig. 23).

9. With respect to claim 4, arguments analogous to those presented for claim 1, are applicable.

10. With respect to claim 5, arguments analogous to those presented for claim 1, are applicable.

11. With respect to claim 6, arguments analogous to those presented for claim 2, are applicable.

12. With respect to claim 7, arguments analogous to those presented for claim 3, are applicable.

13. With respect to claim 8, Mori discloses a network printing system comprising:
a host computer for generating and transmitting print data (col. 7, lines 5-17); and
printer that is connected via a network to said host computer (fig. 2), and

said host computer comprising:
user interface means for providing information for a user and for accepting
instructions from said user (col. 7, lines 5-17);

print data generation means for converting, into print data, a file that is
designated via said user interface means (col. 7, lines 5-17); and

communication means for communicating with said printer (fig. 2).

With respect to rest of the claim, arguments analogous to those presented for claim 1, are applicable.

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14. With respect to claim 9, arguments analogous to those presented for claim 2, are applicable.

15. With respect to claim 11, arguments analogous to those presented for claim 3, are applicable.

16. With respect to claim 12, Mori discloses a network printing system (fig. 1) comprising:

a computer having a file transfer protocol client for transmitting a document file to be printed in accordance with a file transfer protocol (col. 6, lines 56-61 & col. 18, lines 23-25); and

a printer being connected to said computer via a network and having a file transfer protocol file server (network printer apparatus 20 in fig. 1), said file transfer protocol file server comprising:

storage means (hard disk 24) for storing said document file that is received (col. 6, lines 24-44 & col. 7, lines 26-29);

configuration file generation means for employing print setup information in said document file and an initial value that is set in advance to generate a configuration file concerning a print setup for said document file (col. 7, lines 30-40);

print setup reference means for employing said configuration file to generate a menu that lists the contents of said print setup, and for transmitting said menu to said computer (fig. 23 & col. 20, line 54 – col. 22, line 60); and

setup change means for, when said menu is operated by said computer, updating the contents of said print setup in accordance with an operation (col. 19, lines 1-18),

wherein said document file stored in said storage means is printed in accordance with said configuration file (col. 20, line 54 – col. 22, line 60).

Also, read col. 7, line 18 – col. 8, line 46.

17. With respect to claim 13, Mori discloses a printer, which is connected to a computer via a network, comprising:

a file transfer unit (LAN adapter portion) that exchanges information with said computer via said network (col. 6, lines 48-52);

a storage unit (hard disk 24) that stores a document file to be printed that is received from said computer via said file transfer unit (col. 6, lines 24-44 & col. 7, lines 26-29);

a configuration file generator that employs print setup information in said document file, which is received from said computer via said file transfer unit, to generate a configuration file concerning a print setup for said document file (col. 7, lines 30-40);

a print setup reference unit that employs said configuration file to generate a menu indicating contents of said print setup, and for transmitting said menu via said file transfer unit to said computer (fig. 23 & col. 20, line 54 – col. 22, line 60);

a setup change unit that updates contents of said print setup when said computer operates said menu via said file transfer unit (col. 19, lines 1-18), and

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a printing unit that prints said document file that is stored in said storage unit in accordance with said configuration file (col. 20, line 54 – col. 22, line 60).

Also, read col. 7, line 18 – col. 8, line 46.

18. With respect to claim 14, arguments analogous to those presented for claims 1 and 8, are applicable.

19. With respect to claim 15, arguments analogous to those presented for claim 12, are applicable.

20. With respect to claim 16, arguments analogous to those presented for claim 13, are applicable.

21. With respect to claim 17, arguments analogous to those presented for claims 1 and 8, are applicable.

22. With respect to claim 18, arguments analogous to those presented for claim 12, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori as applied to claim 9 above, and further in view of Martin et al. U.S. Patent No. 5,819,015 (hereinafter Martin).

23. With respect to claim 10, Mori discloses a network printing system according to claim 9, but it does not expressly disclose that when said host computer moves said print data included in said menu to a different print via said user interface means, said print data stored in said storage means is transmitted to said different printer.

Martin, the same field of endeavor of the network printing, discloses a network printing system (fig. 1) comprising:

- a first printer for storing a print data file (col. 13, lines 30-54);

- a host computer for initiating a transfer of the print data file from the first printer to a second printer via a graphic user interface (fig. 8); and

- the second printer for receiving and storing the print data file transmitted from the first printer (col. 13, lines 30-54 & Abstract).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the print data file transfer method of Martin into the network printer of Mori.

The suggestion/motivation for doing so would have been to print the print data file stored in a printer at a remote/different printer.

Therefore, it would have been obvious to combine Mori with Martin to obtain the invention as specified in claim 10.

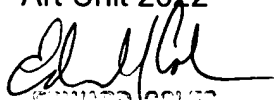
Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
April 20, 2005

Chan S. Park
Examiner
Art Unit 2622

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COMMERCIAL PATENT
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